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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,349	10/21/2003	Jose B. Rivera	BCI-168US	4160
23122	7590	06/23/2008	EXAMINER	
RATNERPRESTIA			FLETCHER III, WILLIAM P	
P O BOX 980			ART UNIT	
VALLEY FORGE, PA 19482-0980			PAPER NUMBER	
			1792	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/690,349

## Applicant(s)

RIVERA ET AL.

## Examiner

William P. Fletcher III

## Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2008, has been entered.

### ***Response to Amendment***

2. Claims 1-30 remain pending.

### ***Election/Restrictions***

3. Claims 1-16 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2006.

### ***Response to Arguments***

4. Applicant's arguments, see the remarks, filed June 12, 2008, with respect to the rejection(s) of claim(s) set forth in the prior Office action, have been fully considered and are persuasive. Rivera neither teaches nor suggests the newly added limitation requiring that "aluminum, iron and zinc are present in the aluminum, iron and zinc alloys respectively in an amount greater than that of every other element in the aluminum, iron and zinc alloys, respectively." Therefore, the rejection has been withdrawn. However,

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upon further consideration, a new ground(s) of rejection is made in view of Marsh et al. (WO 92/08822 A1).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 17-30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (WO 92/08822 A1) in view of Rivera et al. (US 6,126,997 A).

A. Claim 17

i. Marsh teaches a method for treating a metal surface to improve paint adhesion and corrosion resistance [1:7-16] comprising contacting the metal surface with an aqueous composition including an organo-functional silane [6:13-

27], a compound of a group IV-B element [2:bottom-5:middle], and a polymeric film-former [5:bottom]. The metal surface may be aluminum or zinc [1:top].

ii. Marsh does not expressly teach the claimed polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups.

iii. Nevertheless, Marsh teaches that the "organic film-forming polymer may be any polymer which is available as and curable in an aqueous solution dispersion or emulsion" [5:bottom].

iv. As noted in the prior Office actions, Rivera teaches a film-forming composition for the delivery of an adhesion promoting/corrosion resisting compound to the surface of a metal, the composition meeting the above-mentioned limitation.

v. It would have been obvious to one skilled in the art to modify the process of Marsh so as to utilize, as the organic film-forming polymer, the composition taught by Rivera: a polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups. One skilled in the art would have been motivated by the desire and expectation of successfully providing a film-former for delivery and coating of the paint adhesion/corrosion resistant composition.

B. Claim 18

Rivera teaches the limitations of this claim as detailed in prior Office actions.

C. Claims 19 and 20

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Marsh teaches 2-15 wt.-% organosilane and the film-former may be present in an amount of 2-20 wt.-%, which is inclusive of a ratio of 1:1.

D. Claim 21

Marsh teaches 3-aminopropyl-triethoxysilane [6:middle].

E. Claim 22

Rivera teaches the limitations of this claim as detailed in prior Office actions.

F. Claim 23

Rivera teaches the limitations of this claim as detailed in the prior Office action.

G. Claim 24

i. Marsh does not teach that the group IV-B element is part of a compound that is fluorozirconic acid, fluorotitanic acid, and fluorohafnic acid.

ii. Nevertheless, Marsh expressly teaches that the film-forming polymer compositions suitably may already contain corrosion inhibitors [5:bottom].

iii. Rivera teaches that the polymeric film-forming composition additionally contains these compounds as corrosion inhibitors [5:32-41, for example] and it would have been obvious to one skilled in the art to incorporate them with the film-former into the process of Marsh, as such is expressly envisioned by Marsh.

H. Claim 25

As noted above, Marsh teaches an aluminum surface.

I. Claims 26-30

i. While Marsh teaches painting with a polyester or alkyd paint, this reference does not expressly teach the claimed cleaning and drying limitations or painting with acrylic paint.

ii. Rivera teaches the claimed cleaning and drying pretreatment recited in these claims, as noted in prior Office actions. It would have been obvious to one skilled in the art to modify the process of Marsh so as to clean and dry the substrate prior to coating treatment as such is known in the art for providing a contaminant-free surface. Further, it would have been obvious to modify the process of Marsh so as to clean and dry with the compounds and in the fashion claimed as such is taught by Rivera as being effective for the cleaning of a metal surface.

iii. Further, Rivera teaches the claimed paint, as detailed in the prior Office actions. It would have been obvious to one skilled in the art to modify the process of Marsh so as to apply the claimed acrylic paint as such is taught by Rivera as being effective for coating an adhesion-promoted, corrosion-protected metal surface.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

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272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM; on campus every Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/William Phillip Fletcher III/**

Primary Examiner

June 16, 2008